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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/730,273

12/09/2003

Laval Chan Chun Kong

VIRO-6

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23599 7590 03/29/2007
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EXAMINER

CHANG, CELIA C

ART UNIT

PAPER NUMBER

1625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

03/29/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/730,273

Applicant(s)

CHAN CHUN KONG ET AL.

Examiner

Celia Chang

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1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

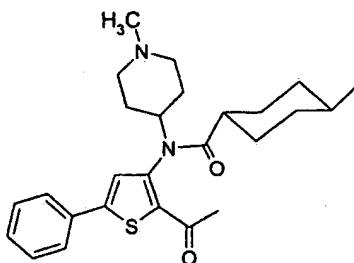
Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Amendment and response filed by applicants dated Jan. 3, 2007 have been entered and considered carefully.

In the previous office action it was delineated based on “factual evidence” that nucleosides are known conventional antiviral products. Therefore, a nucleoside conjugated W and formula I does not depend solely on the structure as



for activity but the combined theinyl-uracil-sugar structure for their activity. Such compounds do not share the same core as the W being non-nucleoside compounds. It is further evidenced that since the conjugates are active, the nucleoside-carbonyl is not a prodrug thus are not obvious variation of the above structure. Attorney's imagination that applicants prodrug would be beneficial to have some activity cannot be relied upon. Please note that applicants used the textbook by the same Buungaard. Nowhere on pages 2-3 recited that applicants' prodrugs are active on its own and not depend solely on the converted “drug” for activity.

Applicants argument that group V “merely recite an additional component” is an over simplification of a combination product. For a combination product, applicants must be in possession of all the elements in the combination. The only element applicants are in possession is the compounds of formula I. Attorney provided no evidence that applicants are in possession of all viral serine protease inhibitor, viral polymerase inhibitor,.....etc. which includes those have not yet be discovered. There is no factual evidence that such combination encompassing compounds with unknown development of the future would have the same inventive concept as compounds per se.

Claims qualify for rejoinder will be made upon finding of an allowable scope for the elected product claim. The rejoinable process claim must depend from or otherwise include all

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the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is *presented prior to* final rejection or allowance, whichever is earlier, free from all 112 issues.

Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be **allowable**, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim or to contain any 112 issues will not be rejoined. See “Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*; *In re Brouwer* and 35 U.S.C. § 103(b),” 1184 O.G. 86 (March 26, 1996).

The restriction has been made final in the previous office action. It is recommended that the non-elected subject matter or claims be deleted from the pending claims without prejudice against applicants’ filing of divisional applications.

Claims 9, 18, 23 and claims 1-8, 15 reading on claims 9, 18 and 23 continuously are prosecuted. The remaining subject matter of claims 1-8, 15, 23 and claims 10-14, 16-17, 19-22 stayed withdrawn from consideration.

2. The rejections of claims 9, 18, 23 and 1-8, 15 reading on the elected compounds under 35 USC 103(a) over *Chan Chun Kong et al. ‘741*, or *Kong et al. ‘741* in view of *Bundgaard*, are maintained for reason of record.

Applicants argued that the *Kong et al. ‘741* patent does not qualify under 35 USC 102(e) as prior art because they are commonly owned. Please note that the *Kong et al. ‘741* is by “another” since the inventorship are different and was *filed* prior to the instant provisional application. The reference is properly applied under 35 USC 102(e). MPEP §706.02(1)(2)

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stated that applicants have the burden to provide evidence that the claimed invention were at the time the invention was made owned by the same person or subject to an obligation of assignment to the same person.

Attorney provided not such evidence except that currently the application and the issued patent were commonly owned. The assignment record of the instant application was record Mar. 4, 2005, thus, no verification that the application and the issued patent "*at the time the invention was made*" was commonly owned.

In addition, MPEP §706.02(1)(2) clearly stated that the common assignment placing the reference under 35 USC 103(c) only applies to prior art in an obviousness rejection. The double patenting should still be made as appropriate.

3. The rejection of claims 1-9, 15, 18, 23 under the judicially created doctrine of obviousness type double patenting over claims 1-174 of US 6,881,741 or the provisional rejection over claims 25-101 over SN 10/730,272, which are drawn to the interchangeable cyclohexyl moiety in place of the instant piperidine (see US 6,881,741 compounds 573,287, 563-567) are maintained for the reason of record and the above explanation.

No terminal disclaimer has been filed.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

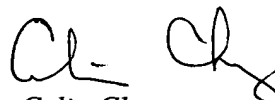
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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 571-272-0679. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie, Ph. D., can be reached on 571-272-0670. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

OACS/Chang
Mar. 26, 2007


Celia Chang
Primary Examiner
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